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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,039	06/14/2001	Takeo Katsuda	011350-276	5950

7590 12/24/2008

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ART UNIT	PAPER NUMBER
2445	
MAIL DATE	DELIVERY MODE
12/24/2008	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/880,039
Filing Date: June 14, 2001
Appellant(s): KATSUDA, TAKEO

Katsuda
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed September 23, 2008 appealing from the Office action mailed March 21, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Non-Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,421,707	Miller et al.	07-2002
5,493,692	Theimer et al.	02-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al. (US006421707B1).

With regard to *claims 14 and 31*, Miller discloses,

- *an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;* (Miller, col.1, lines 41-51, lines 54-58; col.3, lines 33-38; col.6, lines 25-40; col.9, lines 24-28; fig.7)

Miller teaches of *"[allowing] the selective retrieval and formatting of messages sent to a mobile subscriber"* (Miller, col.6, lines 26-27). Miller discloses *"the present invention permits a subscriber to a wireless communications service to receive and generate multimedia messages from known wireless personal communications devices, i.e., cellular telephones"* (Miller, col.1, lines 44-46). Hence, Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller and a receipt notification is selectively generated and delivered to the mobile subscriber.

- *an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;* (Miller, col.1, lines 52-55; col.3, lines 33-38; col.4, lines 40-43; col.9, lines 41-46)

  Miller discloses, *"importantly, the output need not be a 'message' but could simply be notification that a message has been received"* (Miller, col.3, lines 34-36). Hence, Miller teaches of an environment where a receipt notification is generated and delivered to the mobile subscriber in response to receiving a message. In addition, Miller's environment allows the subscriber the ability to customize the message receipt notification through the use of a user-specific agent.

- *an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;* (Miller, col.1, lines 52-55; col.9, lines 41-46)

  Miller teaches of an environment where a receipt notification is generated and delivered to the addressee.

- *an instruction receiving device receiving an E-mail including an instruction for specifying one of multiple image output devices;* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)
  Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference. According to Miller, the *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] … the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163"* (Miller, col.3, lines 33-38).
- *a converting device converting the attachment file portion into data of a format acceptable to the image output device; and* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)
  Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference. According to Miller, the *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] …*

the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163" (Miller, col.3, lines 33-38).

- *a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

  Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 38, 40, 42, and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US006421707B1) and in view of Theimer et al. (US005493692A).

With regard to claims 38, 40, 42, and 44-46, Miller discloses,

- *receiving E-mail addressed to a certain destination;* (Miller, col.1, lines 41-51, lines 54-58; col.3, lines 33-38; col.6, lines 25-40; col.9, lines 24-28; fig.7)

Miller teaches of *"[allowing] the selective retrieval and formatting of messages sent to a mobile subscriber"* (Miller, col.6, lines 26-27). Miller discloses *"the present invention permits a subscriber to a wireless communications service to receive and generate multimedia messages from known wireless personal communications devices, i.e., cellular telephones"* (Miller, col.1, lines 44-46). Hence, Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller and a receipt notification is selectively generated and delivered to the mobile subscriber.

- *preparing receipt notice E-mail based on the received E-mail;* (Miller, col.1, lines 52-55; col.3, lines 33-38; col.4, lines 40-43; col.9, lines 41-46)
  Miller discloses, *"importantly, the output need not be a 'message' but could simply be notification that a message has been received"* (Miller, col.3, lines 34-36). Hence, Miller teaches of an environment where a receipt notification is generated and delivered to the mobile subscriber in response to receiving a message. In addition, Miller's environment allows the subscriber the ability to customize the message receipt notification through the use of a user-specific agent.
- *transmitting said receipt notice E-mail to said destination;* (Miller, col.1, lines 52-55; col.9, lines 41-46)
  Miller teaches of an environment where a receipt notification is generated and delivered to the addressee.
- *selecting one of multiple image output devices on the basis of the location information of said destination acquired;* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference. According to Miller, the *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] … the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163"* (Miller, col.3, lines 33-38).

- *sending an E-mail to said destination containing a notification of the selected image output device; and* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

  Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference. According to Miller, the *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] … the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163"* (Miller, col.3, lines 33-38).

- *transmitting at least a portion of the data of the received E-mail to the selected image output device.* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

  Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

However, Miller does not explicitly disclose,

- *acquiring location information of said destination;*

Theimer teaches,

- *acquiring location information of said destination;* (Theimer, col.8, lines 40-58; col.9, lines 7-20; col.24, lines 8-48; fig.16)

  Theimer teaches of an environment where a message is received at a portable terminal unit, the available delivery methods based on the location of the subscriber are detected, and delivering the data to the appropriate output or display device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Theimer with the teachings of Miller to selectively deliver messages to a subscriber of the wireless service base on the available as well as appropriate output or display methods in proximity to the subscriber. According to Theimer, it is advantageous to *"provide a system in which the delivery of electronic messages to a particular user or users may be selective, depending upon the context or state of the user or users. Furthermore, appropriate*

computing devices for particular actions, such as delivery of electronics messages, are selected based on the environment in proximity to the user in relation to the properties of the message" (Theimer, col.4, lines 5-12).

(10) Response to Argument

With regard to *claims 14 and 31*, the Applicant points out that:

- *Independent claims 14 and 31 recite, in combination with other features, an E-mail transmitting device transmitting to said portable terminal unit a receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices.*
- *However, the claimed feature of an E-mail identifying multiple prospective image output devices is not disclosed. Nor is it addressed in the rejection. The Miller patent does not describe the claimed step of transmitting an E-mail identifying multiple prospective image output devices. It only discloses the selective sending of a receipt notification.*
- *The system of Miller does not provide an E-mail identifying multiple prospective image output devices as recited in independent claim 14. As stated in column 1, lines 54-58 of the Miller patent, "The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network." (emphasis added). This is not the same as the claimed feature.*

However, the Examiner finds that the Applicant's arguments are not persuasive because Miller discloses in *figures 4(j), 4(n), 4(q), and 4(t)* the possible delivery

methods determined by the system such as *"mail forwarding"* via the internet and the e-mail system, *"SMS"* via the display 412 of the handset 411, *"fax"* via a specified facsimile machine, or *"voice"* via the public switched telephone network and notifying the subscriber of these selected available methods. In other words, Miller teaches of the system presenting the subscriber with the system selected outputting methods. Miller discloses, *"in this instance, Thomas chooses to receive more of the main body using SMS. That is, more of the main body will be sent to the handset 411 as text. FIG. 4(k) shows that the handset has received more of the main body of the e-mail text that is displayed in the display 412"* (Miller, col.5, lines 50-54). Hence, Miller teaches of the subscriber confirming with the system in using SMS as the selected delivery method via the display 412 of the handset 411. In other words, Miller teaches of the system presenting SMS as one of the selected delivery methods to the subscriber and that the subscriber confirming with the system of using SMS as the delivery method via the display of the handset.

With regard to *claims 38, 40, and 42*, the Applicant points out that:

- *Independent claims 38, 40 and 42 recite selecting one of multiple image output devices and "sending an E-mail to a certain destination containing a notification of the selected image output device." Thus, a notification email is sent to the destination of an original incoming email that has been received, and this notification email identifies an image output device on which data from the original email is to be output. Independent claim 44 recites a similar notifying feature as independent claims 38, 40 and 42.*

- *After carefully considering the Examiner's arguments, the characterization of the Miller system, the language quoted from Column 3 of the Miller patent, and the other cited columns and lines, the Appellant was unable to find the claimed feature of a sending an E-mail to the certain destination containing a notification of the selected image output device in the Miller patent.*
- *There is no mention of an e-mail containing a notification of the selected image output device being sent to the certain destination. The Miller patent describes a notification acknowledging receipt of a message and delivery of the message to an output device indicated by the subscriber.*

However, the Examiner finds that the Applicant's arguments are not persuasive because Miller discloses, *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] … the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163"* (Miller, col.3, lines 33-38). Hence, Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

With regard to *claims 44-46*, the Applicant points out that:

- *The cited portions of the Miller patent, i.e., column 1, lines 47-58, column 2, lines 58-64, column 5, lines 35-49, column 6, lines 14-19 and column 9, lines 40-*

46, do not disclose a processor for generating at least one E-mail containing information on at least one output device to which at least part of the E-mail is to be output as recited in independent claim 44.

- *Further, the Examiner has not provided a citation in the Theimer patent that discloses the claimed features of a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least a part of the E-mail is to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination.*

However, the Examiner finds that the Applicant's arguments are not persuasive because Miller discloses, *"Once the mail is received by the service controller 713, it is handled according to filtering and forwarding rules 715 that are pre-established by a service subscriber, typically an individual for whom individual mail messages are addressed. As previously described, the filtering and forwarding rules are flexible, and permit the filtering and forwarding of mail messages in any manner capable of being specified as a rule. After the appropriate handling is determined, notification of the mail receipt may then be transmitted a subscriber handset 720, as appropriate"* (Miller, col.9, lines 37-46). Hence, Miller teaches of a controller (i.e., Applicant's processor) appropriately handling the received messages and notifying the subscriber's handset as appropriate.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Thomas Duong/

Patent Examiner, Art Unit 2445

December 24, 2008

Conferees:

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